

## REMARKS

Claims 1-35 are pending in the application. It is gratefully acknowledged that the Examiner has still found allowable subject matter in Claims 24 and 25. However, in the Office Action, the Examiner has rejected the claims as follows: Claims 1, 2, 4, 8-11, 16-19, 26-29, 34 and 35 under 35 U.S.C. § 103(a) as being unpatentable over 3<sup>rd</sup> Generation Partnership Project 2, C.S0005-0 Version 1.0 (3GPP2) in view of St.-Pierre (U.S. Patent 5,883,888); Claim 3 under 35 U.S.C. § 103(a) as being unpatentable over the 3GPP2 in view of St.-Pierre and further in view of Davis et al. (U.S. 4,612,637); Claims 5, 7, 12, 14, 20, 22, 30 and 32 under 35 U.S.C. § 103(a) as being unpatentable over the 3GPP2 in view of St.-Pierre and further in view of Herring (U.S. 6,011,806); Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over the 3GPP2 in view of St.-Pierre and Davis, and further in view of Herring; and, Claims 13, 15, 21, 23, 31 and 33 under 35 U.S.C. § 103(a) as being unpatentable over the 3GPP2 in view of St.-Pierre and Herring, and further in view of Davis.

With regard to the rejection of independent Claims 1, 9, 17 and 27 under §103(a), the Examiner asserts that the 3GPP2 in view of St.-Pierre teaches all the elements of these claims. Claims 1, 9, 17 and 27 recite that the sequence number is used to identify two or more channel assignment messages. As recited in the pending claims, the purpose of “a sequence number” is for identifying a plurality of supplemental channel assignment messages transmitted from a base station, which is different from the process defined by 3GPP2.

The 3GPP2 teaches that a base station identifies a sequence number that includes a supplemental channel assignment request message of a reverse channel transmitted from a mobile station and the base station sends the mobile station a supplemental channel assignment response message including the same value as the sequence number of the supplemental channel assignment request message transmitted from the mobile station to the base station. The Examiner states that St.-Pierre discloses the limitation of using a sequence number for identifying two or more messages.

St.-Pierre at col. 5, lines 37-54, discloses a sequence number 54(1) which is assigned to a

frame. St.-Pierre relates to sending duplicate information from two base stations to a mobile station. The sequence numbers of the duplicate information are identical to each other. The information from each base station is the same information. The sequence number from each base station is the same sequence number.

A single sequence number, recited in each of the independent claims of the present application, is used to identify two or more channel assignment messages. Therefore, a sequence number used to identify multiple messages is not the same as the same sequence number used to identify the same information.

The claims of the present application disclose that a base station transmits a supplemental forward channel assignments message including a sequence number to a mobile station, without receiving a supplemental channel assignments request message from the mobile station, and then, based on the above, the base station assigns supplemental channel; the supplemental channel assignments message includes a sequence number to identify a plurality of supplemental channel assignment messages. In other words, the purpose of a sequence number is for identifying two or more supplemental channel assignment messages.

The apparatus disclosed in the cited reference provides soft handoff without break in a CDMA communications system. Referring to Fig. 4, after a mobile station detects a need of handoff to the second base station by communication (42) with the first base station, a mobile switching center (MSC) instructs (48) the second base station to establish communication with the mobile station. Then, the mobile station handles duplicate communications through both the first and the second base stations (50). Thereafter, the mobile station receives frames from the first and second stations (58) and determines whether sequence numbers included in the received frames are identical to each other (60) or not. If the frame sequence numbers do not match with each other, the mobile station delays the earlier arriving frame by storing it in a buffer. However, if the frame sequence numbers are identical, the mobile station performs diversity combining (68) of the received duplicate communication. The reference has to compare the included frame sequence numbers because it is possible that the frame received from the first base station

transmission and the frame received from the second base station transmission may not be a duplicate of each other. Additionally, synchronous reception of the duplicated frames may not occur. In other words, the sequence number of the cited reference is used to compare whether the received frames are duplicated or not.

Based on at least the foregoing, withdrawal of the rejection of Claims 1, 9, 17 and 27 under §103(a) is respectfully requested.

Further, even if that which is disclosed by St.-Pierre was analogous to the recitations of the claims of the present application, which it is not, the references cannot be combined since there is nothing in 3GPP2 to suggest adding sequence numbers to the channel assignment messages as proffered by the Examiner. 3GPP2 does not disclose a sequence number used to identify two or more channel assignment messages, and therefore the Examiner is using the present application as motivation (i.e. hindsight) for the combination, and is improper.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). M.P.E.P. 2143.01.

A statement that modifications of the prior art to meet the claimed invention would have been "well within the ordinary skill of the art at the time the claimed invention was made" because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references. *Ex parte Levengood*, 28 USPQ2d 1300 (Bd. Pat. App. & Inter. 1993). See also *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1318 (Fed. Cir. 2000). M.P.E.P. 2143.01. Applicants may argue that the Examiner's conclusion of obviousness is based on improper hindsight reasoning. Any judgment on obviousness is in a sense necessarily a reconstruction based on hindsight reasoning, but so long as it takes into account only knowledge which was within the level of ordinary skill in the art at the time the claimed invention was made and does not include knowledge gleaned only

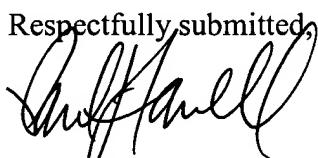
from applicant's disclosure... *In re McLaughlin* 443 F.2d 1392, 1395, 170 USPQ 209, 212 (CCPA 1971). M.P.E.P. 2145.

Since the conclusion of obviousness and the reason for combining could be gleaned only from Applicant's disclosure, the rejection is improper.

Based on at least the foregoing, withdrawal of the rejection of Claims 1- 23 and 26-35 is respectfully requested.

Independent Claims 1, 9, 17 and 27 are believed to be in condition for allowance. Without conceding the patentability per se of dependent Claims 2-8, 10-16, 18-26 and 28-35, these are likewise believed to be allowable by virtue of their dependence on their respective amended independent claims. Accordingly, reconsideration and withdrawal of the rejections of dependent Claims 2-8, 10-16, 18-26 and 28-35is respectfully requested.

Accordingly, all of the claims pending in the Application, namely, Claims 1-35, are believed to be in condition for allowance. Should the Examiner believe that a telephone conference or personal interview would facilitate resolution of any remaining matters, the Examiner may contact Applicant's attorney at the number given below.

Respectfully submitted,  
  
Paul J. Farrell  
Reg. No. 33,494  
Attorney for Applicant

DILWORTH & BARRESE  
333 Earle Ovington Blvd.  
Uniondale, New York 11553  
Tel: (516) 228-8484  
Fax: (516) 228-8516

PJF/MJM/dr